

### **Remarks**

Claims 1-28 are pending. Claim 28 has been added. Entry of the amendment is respectfully requested. No new matter has been added. Reconsideration is respectfully requested.

### **Application Status**

Applicants were requested (at Action page 2) to capitalize the trademark mentioned at specification page 57, line 9.

Claim 4 was rejected pursuant to 35 U.S.C. § 112, first paragraph.

Claims 2, 4, 6, and 24 were rejected pursuant to 35 U.S.C. § 112, second paragraph.

Claims 1 and 5-6 were rejected pursuant to 35 U.S.C. § 102(b) over Graef (US 4,494,747).

Claims 1-4 were rejected pursuant to 35 U.S.C. § 102(b) over Swartzendruber (US 4,159,782).

Claims 1, 7-10, 14-21, and 23 were rejected pursuant to 35 U.S.C. § 102(b) over Beskitt (US 6,302,393).

Claims 11-13 were rejected pursuant to 35 U.S.C. § 103(a) over Beskitt in view of Peters (US 5,267,826).

Claims 21-22 were rejected pursuant to 35 U.S.C. § 103(a) over Beskitt in view of Graef (US 6,783,061).

Claims 24-25 were rejected pursuant to 35 U.S.C. § 103(a) over Force (US 6,109,522) in view of Swartzendruber.

Claims 26-27 were rejected pursuant to 35 U.S.C. § 103(a) over Force in view of Abe (US 4,993,587).

### **The Rejections**

For reasons of brevity, claim language may be referred to herein in a shortened version. For example, language such as "at least one" may be simply referred to as "a". Any generalized statement herein is not to limit any of the mentioned claims in any manner. Please refer to the specific claim for the exact claim language.

### **35 U.S.C. § 112, First Paragraph, Rejection**

Claim 4 was rejected pursuant to 35 U.S.C. § 112, first paragraph, as non enabling. Applicants respectfully disagree.

As explained in an exemplary embodiment (e.g., specification pages 7-8), a single note may be picked from a stack along with an (inadvertent) overlying sheet. The additional sheet can be moved relative to the sheet being picked to facilitate sheet separation. The specification at page 8 discusses an approach where the additional sheet is moved a further distance (in a direction towards the stack) than the underlying (bottom) sheet (is moved towards the stack). This approach includes moving the overlying sheet for "a longer period of time" towards the stack (e.g., page 8, lines 9-11; page 42, lines 10-12). As explained in the specification, this action (time of movement towards the stack for the overlying sheet being longer than the time of movement for the underlying sheet) can facilitate separation between the sheets.

Applicants' specification is enabling for claim 4. The originally filed disclosure, which includes the specification portion and the claim portion (with claim 4), enables one skilled in the art to make and use the invention recited in claim 4. Thus, Applicants respectfully request that the rejection be withdrawn.

### **35 U.S.C. § 112, Second Paragraph, Rejection**

Claims 2, 4, 6, and 24 were rejected pursuant to 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants respectfully traverse these rejections.

Applicants' claims are not indefinite. Thus, Applicants respectfully request that the rejections be withdrawn.

#### **Claim 2**

The Action's assertion that "it appears as though the first note moves in the second direction" is unclear. Claim 1 recites "moving a first note . . . in a first direction" (step a) and "moving the at least one additional note in a second direction" (step d). Claim 2 recites that step (d) includes "moving the at least one additional note in *the* second direction . . .". Claim 2 is not indefinite.

#### **Claim 4**

Claim 4 recites "moving the at least one additional note in the second direction for a longer period of time than the first note is moved in the second direction". Specification support can be found at page 8, lines 9-11, and page 42, lines 10-12.

The claim does not recite "the first note moving in the second direction", as alleged in the Action. Nor does the claim require movement of the first note to meet definiteness. Rather, the claim recites a timing of the additional note movement relative to the first note. The period of time that the additional note is moved is longer than any period of time the first note is moved.

Claim 4 is not indefinite. Added claim 28 recites moving the first note.

### **Claim 6**

Claim 6 depends from claim 5. The language "*the* at least one moving member" of claim 6 has support in the "at least one moving member" of claim 5. Claim 6 is not indefinite.

### **Claim 24**

Applicants respectfully traverse the rejection. Original claim 24 was not indefinite. For example, a stripper member having a circumferential surface can engage many non-aligned notes, including the first note. Nevertheless, claim 24 has been amended as requested to advance prosecution.

### **35 U.S.C. § 102(b) Rejections**

For reasons of brevity the Applicants have not necessarily presented all of the reasons as to why the applied references do not anticipate the claims. Nevertheless, Applicants' remarks show that the applied references do not disclose each and every element of the claimed invention arranged in the manner recited in the claims, as is required to sustain the rejections. Therefore, the applied references cannot anticipate the claims. Hence, Applicants' claims patentably distinguish over the applied references.

### **Graef (US 4,494,747) does not anticipate the claims**

Graef teaches a feed roller (28), counter rotating rollers (44), and note thickness gauging rollers (47). The counter rotating rollers (44) are intended to prevent having an additional note move from the stack (col. 11, lines 8-18). If an additional note is sensed at the thickness gauging rollers (47), then the feed roller (28) is reversed to (alone) drive all of the notes (i.e., end note and

additional notes) back into the stack (col. 12, lines 14-20). During this drive reversal the counter rotating rollers (44) are not driven because of the one-way clutch (24a) (col. 12, lines 21-27). However, the one-way clutch (24a) allows the rollers (44) to freely rotate in the reverse direction.

### **Claim 1**

Graef does not (at least) teach recited step (d). Where does Graef teach moving the additional note back into the stack relative to the end note in response to sensing that the additional note has moved from the stack past the stripper member? In Graef the "note collection" (col. 12, lines 15-16), which includes both the additional note and the end note, is moved together via the reversed feed roller (28) (not the rollers 44) as a single unit back into the stack. That is, the additional note is not moved "relative to" the end note. Graef actually teaches against having the additional note move relative to the end note. Graef does not anticipate claim 1.

### **Swartzendruber does not anticipate the claims**

Claim 1 was rejected pursuant to 35 U.S.C. § 102(b) over Swartzendruber. The Action alleges that Swartzendruber teaches a stack of notes (C), stripper member (44, 46), and sensor (84).

### **Claim 1**

Swartzendruber teaches a picker assembly (14) having a picker belt (48) that picks notes. During feeding, a solenoid (64) is actuated to bring the picker belt (48) into contact with the notes in the storage bin (12). When multiple notes are detected, notes are driven backwards toward the storage bin (12).

With Swartzendruber's arrangement, as shown in Figure 1, the solenoid (64) would deactivate upon multiple note detection. This action causes the picker belt (48) to move out of contact with notes in the storage bin (12). The picker belt (48) is moved out of the way to permit the notes to be driven backwards toward the storage bin. Otherwise the force generated by the picker belt (48) against the notes, along with the contact surface area of the picker belt being larger than that of the backwards driving roller (46), would prevent backwards movement of the notes.

Swartzendruber does not (at least) teach moving an additional note in a second direction opposed of the first direction relative to the first note while the first note is engaged with the picking member, responsive to sensing that the additional note has moved with the first note past the stripper member. There is no teaching in Swartzendruber that the first note would be *engaged* with the picking member (48) *while* the first note is moved backwards. Conversely, Swartzendruber teaches against the recited invention. Swartzendruber purposely disengages the picking member (48) from the first note to permit all the notes to be driven backwards. Swartzendruber does not anticipate claim 1.

#### **Beskitt does not anticipate the claims**

Claim 1 was rejected pursuant to 35 U.S.C. § 102(b) over Beskitt. The Action alleges that Beskitt teaches a stack of notes (234), picking member (190), stripper member (258), and sensor (207).

### **Claim 1**

Applicants traverse the allegation that Beskitt's feed roll (190) constitutes the recited picking member. Where does Beskitt teach picking the first note from the stack with the feed roll (190) engaged with the first note? Rather, it is Beskitt's picker portion (202) that has a high friction segment for engaging and picking sheets from the stack (col. 12, lines 52-57). Beskitt's feed roll (190) is arranged to apply a greater force (than that applied by a stripper roll 194, 258) to a sheet already picked (col. 13, lines 41-44). It follows that Beskitt does not teach recited step (a) of claim 1.

Even if Beskitt's feed roll (190) constituted the recited picking member as alleged, then Beskitt would not meet recited step (d). Upon doubles detection, the direction of the feed roll (190) is reversed (col. 14, lines 22-26) and the stripper roll (194, 258) rotates freely in this reversed direction (col. 12, lines 35-38; col. 14, lines 27-30). This action causes the sheets (first sheet and additional sheet) to be pulled back toward the stack (col. 14, lines 27-30) as a unit. Where does Beskitt teach that the additional note would be moved relative to the first note in this reversed direction? Beskitt does not anticipate claim 1.

### **The 35 U.S.C. § 103(a) Rejections**

Applicants respectfully traverse the rejections. The references are devoid of any teaching, suggestion, or motivation for combining features of the references so as to produce the recited invention. Nor do the references teach or suggest a desirability of combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed Cir. 1990).

**The Claims Are Not Obvious Over  
Force in view of Swartzendruber**

Claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Force in view of Swartzendruber. The Action (on page 11) alleges that Force teaches a stack (146), first note (188), picking member (78), stripper member (176, 178), and sensor (80). The Action (on page 12) admits that Force does not teach or suggest recited step (d).

The Action (on page 12) alleges that Swartzendruber teaches recited step (d). The Action further alleges that it would be obvious "to employ the method step . . . as taught by Swartzendruber, in the method of Force, for the purpose of transporting one note at a time".

**Claim 24**

In Force, a doubles detection causes the tray (74) to move downward (col. 16, lines 35-41). The pick belt (78) is then run backwards while the stripper wheels (176, 178) rotate freely in this backwards direction (col. 14, lines 42-52). This movement of the pick belt (78) pulls the sheets back toward the stack.

It would not have been obvious to one having ordinary skill in the art to have modified Force with the alleged teaching of Swartzendruber as alleged by the Office. Both the structure and operation of the respective devices of Force and Swartzendruber are not compatible.

For example, as previously discussed, upon a doubles detection in Swartzendruber the picker belt (48) is moved away from the stack, and the stripper roller (46) is driven in the backwards direction. The picker belt (48) can be moved away because the backwards driven notes are still supported between the stripper rollers (44, 46).



In contrast, in Force it is the pick belt (78) that is driven backwards. Nor can the pick belt (78) be moved away from the stack (like in Swartzendruber) because it is needed to support (along with the stripper wheels 176, 178) the backwards driven notes.

The Action does not explain how the alleged modification to Force would or could be made. Since the Action does not explain the rejection with reasonable specificity it also procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989).

Furthermore, the alleged modification to Force would be directly contrary to Force's explicit teaching and would destroy the disclosed and desired utility and operability of the Force teaching. That is, the alleged modification to Force would render the reference inoperable for its intended and desired purpose.

An obviousness rejection cannot be based on a combination of selected features from references if making the combination would result in destroying the utility or advantage of the device shown in the prior art reference (prior to its modification). *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1598-99 (Fed. Cir. 1988). Thus, the Office has not presented a *prima facie* showing of obviousness.

The alleged combination of features from Swartzendruber with features of Force, would destroy Force's ability to function as Force requires. Therefore, the alleged combination is not enabling to one of ordinary skill in the art. A rejection based on an alleged combination of features in multiple references that does not produce an enabled form of what is specifically recited in the claim, is not a proper rejection. *In re Kumar*, Case No. 04-1074 (Fed. Cir. August 15, 2005).

The attempts to modify Force are clearly attempts at hindsight reconstruction of Applicants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). The rejection, which lacks the necessary evidence and rationale, is based on knowledge gleaned only from Applicants' disclosure.

The Office has not established a *prima facie* showing of obviousness. The references, taken alone or in combination, do not teach or suggest all of the recited features and relationships. Nor would it have been obvious to one having ordinary skill in the art to have combined the references as alleged to have produced the recited invention.

**The Claims Are Not Obvious Over  
Force in view of Abe**

Claim 26 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Force in view of Abe.

The Action (on page 13) admits that Force does not teach or suggest recited step (b). The Action alleges that Abe teaches recited step (b). The Action further alleges that it would be obvious "to employ the method . . . as taught by Abe, in the method of Force, for the purpose of feeding notes one at a time".

### **Claim 26**

Abe is directed to dispensing telephone cards from a vending machine (e.g., col. 1, lines 7-9). Where does Abe discuss notes? Abe is non analogous art to the recited invention and to Force. Nor would it have been obvious to one skilled in the art to have applied the teachings of Abe to the teachings of Force.

Additionally, Abe cannot alleviate the deficiencies of Force as he does not teach or suggest the recited features and relationships not found in Force. It would not have been obvious to have modified Force with the alleged teachings of Abe to have produced the recited invention. Abe does not teach or suggest recited step (a) or step (b).

Abe does not teach or suggest recited step (a). As previously discussed, where does Abe have notes? Where does Abe teach or suggest that plural notes are moved past a stripper member? Rather, Abe teaches that if two cards are between the lower roller (7) and the upper roller (8), then the lower roller (7) is reversed while the upper roller (8) freely rotates (col. 3, lines 48-61). There is no teaching or suggestion in Abe that two overlapping cards are ever moved past one of the rollers (7, 8) (which, as best understood, are alleged in the Action to be stripper members). Conversely, Abe appears to teach that the overload signal (col. 3, lines 49-50) is immediately generated when two cards become positioned between the rollers (7, 8), which in turn immediately causes a reverse of operation. That is, any overload is detected at the level of the rollers, not downstream thereof. It follows that in Abe, reverse movement is initiated before both cards are ever moved *past* a roller (7, 8). Since Abe does not teach or suggest recited step (a), Abe cannot teach or suggest recited step (b) which is responsive to step (a).

Furthermore, in response to an overload, Abe's roller (8) does not *move* an overlying note in the opposed direction. The roller (8) is not driven, but instead freely rotates (col. 3, lines 53-58). Thus, Abe's upper roller (8) cannot constitute a recited stripper member.

In response to an overload, Abe's roller (7) does not move an overlying note in the opposed direction. Where does the roller (7) move an *overlying* note in engagement with the roller (7)? Further, where does Abe teach or suggest that "the picked note is *not* engaged with" the roller (7)? Thus, Abe's lower roller (7) cannot constitute a recited stripper member. It follows that Abe does not teach or suggest recited step (b). Nor can Abe alleviate the admitted deficiencies of Force with regard to step (b).

It would not have been obvious to one having ordinary skill in the art to have modified Force with the alleged teaching of Abe as alleged by the Office. Both the structure and operation of the respective devices of Force and Abe are not compatible. For example, Force relates to *depositing* currency notes in an ATM (col. 1, lines 10-20), whereas Abe relates to *dispensing* telephone cards from a vending machine (col. 1, lines 7-9). Force has a picker *belt* (78), whereas Abe has a draw *roller* (5) to frictionally engage a card in the stack (3). Force has stripper wheels (176, 178) that share a common axis, whereas Abe has lower and upper (opposite) rollers (7, 8). Force's picker belt (78) is adjacent to and opposite from the stripper wheels (176, 178), whereas Abe's draw roller (5) is distant from the rollers (7, 8).

The Action does not explain how the alleged modification to Force would or could be made. Since the Action does not explain the rejection with reasonable specificity it also procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989).

Furthermore, the alleged modification to Force would be directly contrary to Force's explicit teaching and would destroy the disclosed and desired utility and operability of the Force teaching. The alleged modification to Force would render the reference inoperable for its intended and desired purpose.

An obviousness rejection cannot be based on a combination of selected features from references if making the combination would result in destroying the utility or advantage of the device shown in the prior art reference (prior to its modification). *In re Fine*, supra. Thus, the Office has not presented a *prima facie* showing of obviousness.

The alleged combination of features from Abe with features of Force, would destroy Force's ability to function as Force requires. Therefore, the alleged combination is also not enabling to one of ordinary skill in the art. A rejection based on an alleged combination of features in multiple references that does not produce an enabled form of what is specifically recited in the claim, is not a proper rejection. *In re Kumar*, supra.

The attempts to modify Force are clearly attempts at hindsight reconstruction of Applicants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, supra. The rejection, which lacks the necessary evidence and rationale, is based on knowledge gleaned only from Applicants' disclosure.

The Office has not established a *prima facie* showing of obviousness. The references, taken alone or in combination, do not teach or suggest all of the recited features and relationships. Nor would it have been obvious to one having ordinary skill in the art to have combined the references as alleged to have produced the recited invention.

### **The Dependent Claims**

Each of the dependent claims depends directly or indirectly from an independent claim. The Applicants have shown the independent claims to be allowable. Thus, it is asserted that the dependent claims are allowable on the same basis.

Furthermore, each dependent claim additionally recites specific features and relationships that further patentably distinguish the claimed invention over the applied art. The references do not teach or suggest the features and relationships that are specifically recited in the dependent claims. Thus, it is respectfully submitted that the dependent claims are further allowable due to the recitation of such additional features and relationships. Additionally, Graef (US 6,783,061) does not qualify as prior art to the recited invention.

### **Fee For Additional Claim**

Please charge the fee associated with the submission of one excess total claim (\$50) and any other fee due to Deposit Account 09-0428.

### **Conclusion**

Applicants respectfully submit that this application is in condition for allowance.

The undersigned is willing to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,



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